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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,672	09/08/2000	Takekazu Kumagai	B588-012	3660

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/658,672

Applicant(s)

KUMAGAI, TAKEKAZU

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-31 is/are pending in the application.  
4a) Of the above claim(s) 28-30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 23-27 and 31 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) 28-30 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is in response to amendment filed 4/6/05.

#### ***Response to Amendment***

2. Claims have been amended and new claim has been added.

#### ***Response to Arguments***

3. Applicant's arguments with respect to previously rejected claims have been considered but are moot in view of cancellation of claims 1-22 and presented new claims 23-31 and the new ground(s) of rejections thereof.

#### ***Election/Restrictions***

3. Newly submitted claims 28-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The subject claims refers to elements not present in the originally presented and elected invention (refer to originally elected claims 5/20/2004 and subsequent amendments filed 11/30/04 and 5/12/04 in response to appropriate office actions). The following features of the newly presented claims recite an apparatus which is patentably distinct from the originally claim apparatus of claims 1-8 and 10-12 (originally elected in response filed 5/20/04) and subsequently amended as cited above.

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Claim 28 refers to print processing means and recording means that records at least one of the following status information: the size of the print process, the time, the printing resolution, the type of printing color/monochrome and/or type of finishing process, associated with a memory box.

Claim 30 refers to scan means, accumulation means and recording means wherein the accumulation means accumulates the scanned image, the recording means records at least one of the following status information: the type of scanning color/monochrome, the image size, the paper size and/or the resolution, associated with a memory box.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Accordingly, claims 23-27 and 31 have been examined.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 23 recites the limitation "the unit-cost". There is insufficient antecedent basis for this limitation in the claim.

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7. Claim 24 recites ..said management means manages the unit-cost for each multifunction apparatus. However, there is no support in the claim for more than one multifunction apparatus since the billing management system of claim 23 is directed to a single multifunction apparatus.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 23-27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford (US Pat. 5,901,228 and further in view of Dedrick (US Pat. 6016509).

As per claim 23 and 24 Crawford teaches a billing management system in which a multifunction apparatus (online service system 100 Figures 3 and 4) and a billing management apparatus (Host Computer 104) can communicate via a network, said system comprising a multifunction comprising memory box creating means (col. 29 L 57-67), reception means for receiving a document via a communication line (Figure 4, communication controllers, 112), accumulation means for accumulating the document in the memory box (col. 29 L 57-67, “software needed to satisfy the request”), recording means for recording upon reception of the document in association with a memory box at least one of: the file size, time..(col. 30 L 19-24), transmission means for transmitting the recorded status information to said billing management apparatus (host computer 104 receives the status information for billing col. 45 L 25-27), said

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billing management apparatus comprising: management means for managing unit-cost information ( Fig. 15, block 748, col. 30 L “per-use” basis in association with amount of time the content is used) and calculation means for calculating billing amount for the memory box ..(refer to col. 30 L 19-24).

Crawford discloses the claimed invention except for the billing management apparatus as a distinct and separate billing management apparatus wherein the recorded status information is transmitted via the transmission means for processing billing.

In the same field of endeavor, Dedrick teaches a billing management apparatus (Fig. 1, metering server) connected via transmission means to a multifunction apparatus (metering server 14 connected to yellow page server 22, and regional content server 21) via a communication network.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the billing management system having a multifunction apparatus as disclosed in Crawford to have the billing management means as a distinct apparatus having a transmission means for transmitting the recorded status information to the billing apparatus because this would allow the billing apparatus to interface with a plurality of multifunction apparatus as explicitly disclosed in Dedrick.

Regarding claim 24, Dedrick teaches that the billing management means manages the unit-cost of information for each multifunction apparatus (see Figure 1).

Claim 25: Please refer to analysis of claim 23.

Claim 26: setting means for setting ... (refer to Col. 8, “sign-up” system).

Claim 27: Please refer to analysis of claim 23.

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Claim 31: All limitation of method steps have been addressed as corresponding process performed by respective system elements.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

2/20/06